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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/039,307

10/26/2001

Michael R.S. Hill

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EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

MAIL DATE

DELIVERY MODE

09/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/039,307</p>	<p><b>Applicant(s)</b> HILL ET AL.</p>	
	<p><b>Examiner</b> FRANCES P. OROPEZA</p>	<p><b>Art Unit</b> 3766</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 17-20 and 41-47.  
Claim(s) withdrawn from consideration: 54-61.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Carl H. Layno/  
Supervisory Patent Examiner, Art Unit 3766

/Frances P. Oropeza/  
Patent Examiner, Art Unit 3766  
September 3, 2009

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant's comments filed 8/21/09 have been fully considered, but they are not convincing.

In response to the Applicant's arguments that the references fail to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e., varying the programmed parameters during their delivery, varying the programmed parameters during the associated cardiac pacing therapy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The final paragraph of independent claim 17 is read: there is a means for adjusting the electrical stimulation applied to the nerves, the stimulation of the nerves applied during delivery of the pacing therapy, the adjustments in the electrical stimulation for the nerves being responsive to the one or more physiological parameters of the patient, the parameters being monitored during delivery of the pacing therapy.

Repeating the previous reading of the final paragraph of independent claim 17 and including the citations from Obel et al.: there is a means for adjusting the electrical stimulation (60) applied to the nerves (abstract, lines 1-4; column 5, lines 45-51), the stimulation of the nerves applied during delivery of the pacing therapy (column 3, lines 8-19; column 5, lines 25-44), the adjustments in the electrical stimulation for the nerves being responsive to the one or more physiological parameters of the patient (abstract, lines 4-13; column 3, lines 20-28, 42-45), the parameters being monitored during delivery of the pacing therapy (abstract, lines 13-18).

The Applicant asserts the new claims 54-61 were erroneously restricted as the new claims have limitations corresponding to those of the previously submitted claims, "rewritten very slightly for clarity". The Examiner respectfully disagrees.

The limitations changes associated with new claims 54-61 are significant and are deemed to create a new and distinct invention. The focus in the final paragraph of the independent claim is changed from "electrical stimulation applied during delivery of the pacing therapy (to the heart)" to "electrical stimulation applied during deliver of the electrical stimulation (to the nerves)". Also a second change is made changing the limitation from "the parameters of the patient as monitored during delivery of the pacing therapy" to "parameters of the patient as monitored during contemporaneous delivery of the pacing therapy".

The rejection of record and the restriction of record stand.